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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,741	07/31/2003	Makoto Tsuji	241053US0	1389

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EXAMINER

LE, HOA T

ART UNIT PAPER NUMBER

1773

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/630,741

Applicant(s)

TSUJI ET AL

Examiner

H. T. Le

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 is/are allowed.
- 6) ☒ Claim(s) 2-8 and 10-12 is/are rejected.
- 7) ☒ Claim(s) 9, 13 and 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/03, 11/03 & 01/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. Claims 3-5 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to the dependency of claims 3-5 on claim 2, “vinyl monomer” has no antecedent basis because such feature is not recited in claim 2.

In claim 8, “monomers” (plural) has no clear antecedent basis. Note that only “vinyl monomer” (singular) is recited in claim 1 upon which claim 8 depends.

2. Claims 2, 6, 7 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukui et al.

Claims 2 and 10-12: Fukui et al disclose a cosmetic composition comprising modified powder comprising metal oxide coated with a silicone polymer film. See col. 3, lines 5-13; col. 7, lines 10-14; and col. 10, lines 45-55. The particle size of the metal oxide is limited to 10  $\mu\text{m}$ . See col. 10, lines 62-67. Thus Fukui teaches a polymer composite comprising a silicone-coated metal oxide particles. Fukui does not teach the use of a sunscreen material. However, it would have been obvious for one having ordinary skill in the art to incorporate a sunscreen material into the cosmetic composition taught by Fukui in order to provide the sun protection property to the product. And it would have been obvious to utilize ethyl hexyl methoxy cinnamate because it is a popular commercial sunscreen material known in the art (see for example, US 6,224,852 to Morgan et al, at col. 9,

line 66 to col. 8, line 1). The incorporation of a sunscreen would expectedly provide the sun-protection factor as claimed.

Claim 6: See Fukui, col. 10, lines 45-53.

Claim 7: See Fukui, col. 10, line 67 to col. 11, line 3.

*Allowable Subject Matter*

3. Claim 1 is allowed.
4. Claim 8 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
5. Claims 3-7 and 9-14 are objected to as being alternatively dependent upon the rejected claim 2, but would be allowable if rewritten to be dependent solely on claim 1.
6. The following is a statement of reasons for the indication of allowable subject matter: None of the prior art references of record, singly or in combination, teach a polymer composite containing coated metal oxide and obtained by polymerization vinyl monomer having specific solubility parameter with a crosslinking agent as claimed. The Obe reference (US 3,716,505) teaches a process of polymerization of vinyl monomer utilizing metal oxide as a dispersing agent for the vinyl monomer, not as one of the main components to form a polymer composite as required in the instant claims. In addition, the solubility parameter of the vinyl monomer is not taught, neither is the presence of a crosslinking agent.
7. Other references are cited as art of interest.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to H. T. Le whose telephone number is 571-272-1511. The examiner can normally be reached on 10:00 a.m. to 6:30 p.m., Mondays to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on 571-272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



H. T. Le  
Primary Examiner  
Art Unit 1773